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REMARKS

Claims 1-20 are pending in this application. Claims 2 and 6-9 are amended in this Amendment. The applicant appreciates the examiner's indication of allowable subject matter in claims 2 and 6-9.

The Office action mailed 7 June 2000 (Paper No. 4) provided by the examiner has been read and given careful consideration.

A.

On page 3 of Paper No. 4, the examiner objects to claims 2 and 6-9 and the examiner states that claims 2 and 6-9 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response to the objection, the claims 2 and 6-9 have been rewritten in independent form to include the limitations of base claims and intervening claims.

In view of the foregoing remarks and amendments, it is respectfully believed that claims 2 and 6-9, as amended, are now allowable and that the previous objection should not be carried forward to the claims as now amended.

B.

Claims 1, 3-5, and 10-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over

a proposed combination of U.S. Patent No. 5,943,029 issued to Ross and U.S. Patent No. 6,028,586 issued to Swan et al. The applicant respectfully submits that the examiner has failed to establish a *prima facie* case of obviousness regarding claims 1, 3-5, and 10-20.

To establish a *prima facie* case of obviousness, for a rejection of claims under 35 U.S.C. § 103, three basic criteria must be met. **First**, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. **Second**, there must be a reasonable expectation of success. **Third**, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See the Manual of Patent Examining Procedure (M.P.E.P.) §§ 706.02(j) and 2143, and 35 U.S.C. § 103. If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

The applicant respectfully submits that this § 103 rejection is flawed for several reasons:

1. First, the examiner's proposed combination of Ross '029 and Swan '586 fails to teach or suggest the combination of features claimed in the applicant's claims.
2. Second, Ross '029 does not teach the combination of features that the examiner alleges.
3. Third, Swan '586 does not teach the features that the examiner alleges.
4. Fourth, the examiner fails to show that there is a suggestion to combine elements of

Ross '029 with elements of Swan '586.

The examiner's proposed combination of Ross '029 and Swan '586 fails to teach or suggest the combination of features claimed in the applicant's claims, Ross '029 does not teach the combination of features that the examiner alleges, and Swan '586 does not teach the features that the examiner alleges, for the reasons set forth herein.

Ross '029 describes a method which includes “obtaining information from a user regarding specific capabilities of an attached non-DDC monitor” (Abstract). In the Ross '029 device, “[o]nce the information is entered through SSP 300 or MDP 305, the system **must be rebooted** for the changes to take effect” (column 3 at lines 65-67). When using the Ross '029 device, the user selects a monitor from a list of monitors (column 4 at lines 28-29).

Swan '029 relates “to displaying a plurality of images on a display, where the image update rate and the display update rate are different” (column 1 at lines 6-10). The Swan '029 device is directed at solving the difficulty of “**displaying images that were not specifically designed to be displayed on a computer display, such as images from television broadcasts, VCRs**” (column 1 at lines 39-42).

The examiner readily admits that Ross '029 does not teach all the claim limitations of independent claims 1, 12, and 17. On page 2 of Paper No. 4, the examiner states that Ross '029 does

not show the claimed feature of “determining whether said first data corresponds to second data stored in a memory.” However, Ross '029 is deficient on many other features as well. Ross '029 does not teach the other features of claims 1, 12, and 17.

The examiner relies upon Ross '029 to teach all features of claims 1, 3-5, and 10-20, **other than** the aforementioned “determining” features. The examiner's heavy reliance upon Ross '029 is believed to be flawed and inappropriate because Ross '029 clearly does not teach or suggest all the claim limitations set forth in independent claims 1, 12, and 17, even when an attempt is made to rely upon Swan '586 to remedy the many deficiencies of Ross '029.

Ross '029 and Swan '586 do not teach the combination of features set forth in the applicant's claim 1. Claim 1 sets forth: “A method, comprising: while power is being supplied to a processing unit, detecting whether a video display unit is newly coupled to a connecting unit of said processing unit, said video display unit conveying varying visual information to a user, and said processing unit processing data including the varying visual information; when said video display unit is detected as being newly coupled to said connecting unit while power is being supplied to said processing unit, reading first data corresponding to said video display unit; determining whether said first data corresponds to second data stored in a memory unit; and when said first data does not correspond to said second data stored in said memory unit, storing said first data in said memory unit and determining a resolution corresponding to said video display unit and transmitting said resolution to a video card coupled to said video display unit.”

Ross '029 and Swan '586 do not teach the combination of features set forth in the applicant's claim 12. Claim 12 sets forth: "An apparatus, comprising: a video display unit conveying varying visual information to a user; and a processing unit processing data including the visual information, said processing unit detecting whether said video display unit is newly coupled to said processing unit while power is being supplied to said processing unit, said processing unit reading first data corresponding to said video display unit when said video display unit is detected as being newly coupled to said processing unit while power is being supplied to said processing unit, said processing unit determining whether said first data corresponds to second data stored at said processing unit, wherein said processing unit stores said first data and determines resolution data corresponding to said video display unit and transmits said resolution data when said first data does not correspond to said second data."

Ross '029 and Swan '586 do not teach the combination of features set forth in the applicant's claim 17. Claim 17 sets forth: "A method, comprising: while power is being supplied to a processing unit, detecting whether a video display unit is newly coupled to said processing unit, said video display unit conveying varying visual information to a user, and said processing unit processing data including the visual information; when said video display unit is detected as being newly coupled to said processing unit while power is being supplied to said processing unit, reading first data corresponding to said video display unit; determining whether said first data corresponds to second data stored in a memory unit; and when said first data does not correspond to said second

data stored in said memory unit, storing said first data in said memory unit and determining resolution data corresponding to said video display unit and transmitting said resolution data to a first device."

The examiner attempts to show that Swan '586 teaches the aforementioned claimed "determining" features. However, the applicant respectfully submits that Swan '586 does not show those "determining" features. Nevertheless, even if Swan '586 did teach those "determining" features, which Swan '586 does not do, the § 103 rejection would still be flawed because Ross '029 does not teach the other features of claims 1, 12, and 17.

Claims 1, 12, and 17 claim a combination of features that are not taught or suggested by Ross '029 and Swan '586. The examiner has admitted that Ross '029 does not teach all the features of the applicant's claims 1, 3-5, and 10-20. The applicant respectfully submits that Swan '586 does not remedy the deficiencies of Ross '029. Swan '586 **does not** teach the applicant's claimed feature of "determining whether said first data corresponds to second data stored in a memory" as set forth in claims 1 and 17. Also, Swan '586 **does not** teach the claimed feature of "determining whether said first data corresponds to second data stored at said processing unit" as claimed in claim 12.

Swan '586 does not teach the aforementioned "determining" features of claims 1, 12, and 17. Even if Swan '586 did teach the aforementioned "determining" features of claims 1, 12, and 17, which it does not, the examiner would have still failed to establish *prima facie* case of obviousness,

because the examiner has not demonstrated a critically important element of the requirements of 35 U.S.C. § 103.

It is important to recognize that the examiner has failed to show that there is a suggestion to combine the teachings of Ross '029 with the teachings of Swan '586.

In other words, a critical element of a § 103 case is missing from the instant rejection. There is no specific showing of **motivation** in the prior art to combine and modify Ross '029 with Swan '586. Further, there is no **specific suggestion** in the art of record to make this complex modification, although that too is a requirement under §103.

The examiner asserts on page 2 that Ross '029 discloses most of the applicant's claimed features and that Swan '586 discloses the balance of the applicant's claimed features. But it is clear that Ross '029 states that “the system **must be rebooted** for the changes to take effect” (column 3 at lines 65-67). Then the examiner asserts that “[t]herefore it would have been obvious to one of ordinary skill in the art to combine the methods of Ross and Swan et al to provides [*sic*] a hot-plugging method of display in which a main body of a main computer automatically recognizes a newly connected display device and creating a method and apparatus to provide non-DDC monitor characteristics to system software.”

That is pure, unmitigated 20-20 hindsight of the kind that the Federal Court has repeatedly

condemned since the early 1980s. The statement is impermissible hindsight based on the very teachings of the invention, not based, as it must be under Federal Circuit caselaw, on specific items already in the prior art. You cannot be motivated to combine Ross '029 with Swan '586 unless and until you already know this inventor's invention. The Office action is using Mr. Lee's invention and patent application as a blueprint for how to combine bits and pieces of the prior art to arrive at his invention. The examiner's bare assertions are **not legally sufficient** to show motivation or suggestion for purposes of § 103.

Under governing Federal Circuit caselaw, before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999)(teaching or motivation or suggestion to combine is an “essential evidentiary component of an obviousness holding”); *In re Rouffet*, 149 F.3d 1350, 1355, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998); *In re Chu*, 66 F.3d 292 (Fed. Cir. 1995); *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072 (Fed. Cir. 1994)(“When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination.”); *In re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1943–44 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1586, 1589–90 (Fed. Cir. 1988); *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987); *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 U.S.P.Q.2d 929, 933 (Fed. Cir. 1984).

“Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability.” Doing that is “the essence of hindsight.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). The showing must be “clear and particular.” Broad conclusory statements standing alone are not legally sufficient. *Id.* There must be “particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references.” *Id.* at 1000. The PTO must explain what specific understanding or technical principle would have suggested the combination of references. *Id.*; *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998).

Because there is no suggestion in the prior art, on this record, to combine the elements of Mr. Lee's invention, the § 103 rejection is insupportable and should be withdrawn.

The examiner has not satisfied the requirements set forth in 35 U.S.C. § 103 and M.P.E.P. § 2143 regarding a rejection of claims based on obviousness.

The examiner has failed to establish the aforementioned **first** basic criterion of a *prima facie* case of obviousness because the examiner failed to show that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings, in accordance with M.P.E.P.

§ 2143 and 35 U.S.C. § 103. There is no suggestion or motivation to combine Ross '029 and Swan '586 to arrive at the applicant's claimed invention. In addition, there is no suggestion or motivation to modify Ross '029 and Swan '586 **to arrive at Mr. Lee's claimed invention.**

Furthermore, the examiner has failed to establish the aforementioned **third** basic criterion of a *prima facie* case of obviousness because the examiner failed to show that Ross '029 and Swan '586 teach or suggest all the claim limitations of claims 1, 3-5, and 10-20. The examiner has failed to establish a *prima facie* case of obviousness because the examiner failed to show that the references teach or suggest all the claim limitations, in accordance with M.P.E.P. § 2143 and 35 U.S.C. § 103.

The foregoing reasons show that the examiner has failed to establish a *prima facie* case of obviousness. In view of the noted deficiencies of Ross '029, the inability of Swan '586 to remedy the noted deficiencies of Ross '029, and the unlikely combination as proposed, the applicant respectfully submits that the rejection of claims 1, 3-5, and 10-20 is improper.

Accordingly, in view of the foregoing remarks, the applicant respectfully requests that the rejection of claims 1, 3-5, and 10-20 be withdrawn.

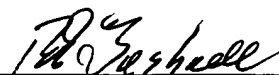
Numerous references were cited by the examiner but not utilized in the rejection of the claims. As recognized by the examiner, these references fail to teach or suggest the specifically recited features of the present invention and accordingly, no further comment on these references

are necessary.

In view of the above, it is respectfully submitted that all claims 1 through 20 of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the examiner is requested to telephone the applicant's attorney.

A fee of \$390.00 is incurred by the addition of five (5) independent claims in excess of 3. The applicant's check drawn to the order of the Commissioner accompanies this Response. Should the check become lost or detached from the file, the Commissioner is authorized to charge Deposit Account No. 02-4943 and advise the undersigned attorney accordingly. Also, should the enclosed check be deemed to be deficient or excessive in payment, the Commissioner is authorized to charge or credit our deposit account and notify the undersigned attorney of any such transaction.

Respectfully submitted,



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